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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,009	12/28/2000	Mohammad J. Arshad	13935-NN016	9068

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INTELLECTUAL PROPERTY LAW DEPARTMENT CASE LLC  
700 STATE STREET  
RACINE, WI 53404

EXAMINER

BROWN, VERNAL U

ART UNIT	PAPER NUMBER
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2635

DATE MAILED: 06/04/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/752,009

**Applicant(s)**

ARSHAD ET AL.

**Examiner**

Vernal U Brown

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

The application of Mohammad J. Arshad for Transponder Communication And Control System For A Vehicle filed December 28,2000 has been examined. Claims 1-23 are pending.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 23 is rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim is narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. Claim 23 is an independent claim in which the system for controlling the vehicle is not defined.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim 1-5 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Flick U.S. patent 6480117.

Regarding claim 1, Flick teaches a method of controlling the operation of a vehicle with a radio communications circuit configured to communicate with a vehicle operator's handheld radio frequency transponder(col. 5 lines 10-14), the method comprising the steps of:  
providing the vehicle having the bi-directional radio communications circuit (col. 5 lines 5 lines 10-12);  
providing the radio transponder to the vehicle operator (col. 7 lines 32-35);  
generating electromagnetic radiation from the radio communications circuit by communicating wirelessly (figure 4);  
bringing the transponder within the range of the electromagnetic radiation (figure 4);  
energizing the transponder by the electromagnetic radiation (col. 8 lines 41-46);  
transmitting first information from the transponder after the step of energizing the transponder (col. 8 lines 52-55);

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receiving at the reader circuit the first information transmitted by the transponder; and  
controlling at least one subsystem of the vehicle (engine start or run enable) in response to the  
first information received at the transponder (col. 8 lines 37-40).

Regarding claim 2, Flick teaches the radio transponder includes a low power  
micro controller (56) configured to receive its operating power from the electromagnetic  
radiation (col. 8 lines 41-46).

Regarding claim 3, Flick teaches providing the radio transponder includes the step of  
molding the radio transponder into a vehicle ignition key (figure 5).

Regarding claim 4, Flick teaches embedding the radio transponder in a hand-held card  
(81, figure 4).

Regarding claim 5, Flick teaches mechanically bonding the radio transponder to a  
Vehicle ignition key by means of a key ring (figure 4).

Regarding claim 17, Flint teaches a system for controlling the operation of a vehicle  
(figure 1) comprising:

a portable transponder (figure 2) including a microcontroller (56) and include digital  
memory for storing the code (col. 10 lines 60-62);

a vehicle comprising a transponder (10) configured to transmit electromagnetic radiation  
sufficient to energize and enable the transponder to transmit the data (col. 8 lines 41-46) and a  
control system configured to input data from the transponder reader circuit (col. 5 lines 26-35).

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flick U.S patent 6480117 in view of Konrad et al. U.S Patent 6020827.

Regarding claims 6-7, Flick teaches each transponder is uniquely coded for identification purposes (col. 6 lines 31-35) but is not explicit in teaching the transmission from the transponder includes a value that identifies the operator. Konrad et al. in an art related invention in the same field of endeavor of vehicle security teaches a transponder providing user identification (col. 1 lines 17-20) and compare the user identification with the previously stored information (col. 1 lines 51-56) in order to verify the identification of the user.

It would have been obvious to one of ordinary skill in the art for the transmission from the transponder includes a value that identifies the operator in Flick as evidenced by Konrad et al. because Flick suggests each transponder is uniquely coded for identification purposes and Konrad et al. teaches a transponder providing user identification and compare the user identification with the previously stored information in order to verify the identification of the user.

Regarding claim 8, Flick teaches controlling the operation of the vehicle engine (col. 8 lines 36-38).

Claims 9-11 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giessl U.S patent 6538557 in view of Flick U.S patent 6480117.

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Regarding claim 9, Giessler teaches a method of controlling the operation of a vehicle in response to data received from a radio transponder (col. 2 lines 40-42), the method includes storing data in the transponder indicative of the operator and downloading the data from the transponder to the vehicle the data indicative of the operator (col. 3 lines 31-37), comparing by the vehicle of the downloaded data indicative of the operator with data previously stored in the vehicle (col. 3 lines 37-40) and limiting the functionality of the vehicle based on the downloaded data (col. 6 lines 31-34). Giessler is however silent on teaching generating by the vehicle of an electromagnetic field sufficient to energize the transponder. Flick in an art related invention in the same field of endeavor of vehicle security system teaches energizing the transponder by the electromagnetic radiation (col. 8 lines 41-46) as a conventional means of powering the transponder.

It would have been obvious to one of ordinary skill in the art for the vehicle to generate an electromagnetic field sufficient to energize the transponder in Giessler as evidenced by Flick because Giessler suggests downloading data from the transponder and power a transponder with the radiated electromagnetic wave from the base unit represents a conventional means of powering a passive transponder.

Regarding claims 10-11, 13, and 14 Giessler teaches operational parameters includes distance traveled, times of day in which the operation of the vehicle is permitted, an elapsed time of operation (col. 1 lines 25-30)

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Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giessler U.S patent 6538557 in view of Flick U.S patent 6480117 and further in view of Rick et al. U.S patent 6552648.

Regarding claim 12, Giessler in view of Flick teaches downloading operational parameters to the vehicle but is silent on teaching (col. 2 lines 40-42, U.S Patent 6538557) but is silent on teaching the operational parameter includes a geographical area. Rick et al. in an art related invention in the same field of endeavor of vehicle control system teaches the operational parameter includes a geographical area in which the vehicle must be driven (col. 4 line 66 -col. 5 line 2).

It would have been obvious to one of ordinary skill in the art for the operation parameters to include a geographical area in which the vehicle must be driven in Giessler in view of Flick because Giessler in view of Flick suggests downloading operational parameters to the vehicle to control the operation of the vehicle and Rick et al. teaches the operational parameters of the vehicle includes defining a geographical area in which the vehicle must be driven.

Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giessler U.S patent 6538557 in view of Flick U.S patent 6480117 and further in view of Doyle U.S Patent 5815071.

Regarding claim 15-16, Giessler in view of Flick teaches downloading operational parameters to the vehicle (col. 2 lines 40-42, U.S Patent 6538557) but is silent on teaching the operational parameters includes the maximum engine load and the speed of the vehicle. Doyle in an art related invention in the same field of endeavor of vehicle control system teaches the



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operational parameter includes the speed of operation of the vehicle and load the engine load (by controlling the RPM) (col. 4 lines 61-64) for controlling the operation of the vehicle.

It would have been obvious to one of ordinary skill in the art for the operational parameters of the vehicle to include the maximum engine load and the speed of the vehicle in Giessler in view of Flick as evidenced by Doyle because Giessler in view of Flick suggests downloading operational parameters to the vehicle and Doyle teaches the operational parameter includes the speed of operation of the vehicle and load the engine load (by controlling the RPM) for controlling the operation of the vehicle.

Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flick U.S. patent 6480117 in view of Doyle U.S. Patent 5815071.

Regarding claim 18-20, Flick teaches transmitting data from the transponder to control the operation of the vehicle (col. 6 lines 9-15) but is silent on teaching the operational parameters includes the speed of the vehicle, engine RPM, and maximum engine load. Doyle in an art related invention in the same field of endeavor of vehicle control system teaches the operational parameter includes the speed of operation of the vehicle and load the engine load (by controlling the RPM) (col. 4 lines 61-64) for controlling the operation of the vehicle.

It would have been obvious to one of ordinary skill in the art for the operational parameters of the vehicle to include the maximum engine load and the speed of the vehicle in Flick as evidenced by Doyle because Flick suggests transmitting data from the transponder to control the operation of the vehicle and Doyle teaches the operational parameter includes the speed of operation of the vehicle and load the engine load (by controlling the RPM) for controlling the operation of the vehicle.

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Claim 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flick U.S patent 6480117 in view of Giessler U.S patent 6538557.

Regarding claims 21 and 23, Flick teaches transmitting data from the transponder to control the operation of the vehicle (col. 6 lines 9-15) but is silent on teaching the vehicle control system is configured to disable the vehicle after a predetermined amount of time of operation based on the data received from the transponder. Giessler in an art related invention of securing a vehicle against unauthorized use by controlling the operation of a vehicle in response to data received from a radio transponder (col. 2 lines 40-42) and disable the vehicle after a predetermined amount of time of operation based on the data received from the transponder (col. 7 lines 65-66).

It would have been obvious to one of ordinary skill in the art for the vehicle control system to be configured to disable the vehicle after a predetermined amount of time of operation based on the data received from the transponder in Flick as evidenced by Giessler because Flick suggests transmitting data from the transponder to control the operation of the vehicle and Giessler teaches securing a vehicle against unauthorized use by controlling the operation of a vehicle in response to data received from a radio transponder and disable the vehicle after a predetermined amount of time of operation based on the data received from the transponder in order to ensure time limit on the use of the vehicle.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Flick U.S patent 6480117 in view of Rick et al. U.S patent 6552648.

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Regarding claim 22, Flick teaches transmitting data from the transponder to control the operation of the vehicle (col. 6 lines 9-15) but is silent on teaching the vehicle control unit configured to disable the vehicle if it travels outside a predetermined area. Rick et al. in an art related invention in the same field of endeavor of vehicle control system teaches a vehicle control unit configured to disable the vehicle if it travels outside a predetermined area (col. 2 lines 25-30) in order to ensure that the vehicle is only used in authorized areas.

It would have been obvious to one of ordinary skill in the art to configure the vehicle control unit to disable the vehicle if it travels outside a predetermined area in Flick as evidenced by Rick et al. because Flick suggests transmitting data from the transponder to control the operation of the vehicle and Rick et al. teaches a vehicle's control unit configured to disable the vehicle if it travels outside a predetermined area in order to ensure that the vehicle is only used in authorized areas.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vernal U Brown whose telephone number is 703-305-3864. The examiner can normally be reached on M-Th, 8:30 AM-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703-305-4704. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-6743 for regular communications and 703-308-6743 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



Vernal Brown

May 29, 2003

MICHAEL HORABIK  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

